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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/506,795	02/18/2000	Alain Bethune	05725.0533-00000	8040
22852	7590	09/22/2004		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			EXAMINER KOCH, GEORGE R	
			ART UNIT 1734	PAPER NUMBER

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/506,795

Applicant(s)

BETHUNE ET AL.

Examiner

George R. Koch III

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26,28-35,72,73 and 76 is/are pending in the application.
- 4a) Of the above claim(s) 7,11,13,15,17-19 and 72 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-10,12,14,16,20-35,73 and 76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/12/2004 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-26, 28-35, 72, 73, and 76 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Neither the specification as originally filed, or the French document incorporated by reference disclose that the pieces of material on the first surface of the supply strip backing have a different size

than the pieces of material on the second surface. Furthermore, the original specification provides no support for centering the pieces of material on the first and second surface of the supply strip.

4. Claim 14 of the French document incorporated by reference does provides support for centering the pieces of material on the first and second surface of the supply strip, and the specification has been amended to included this essential subject matter.

5. It is noted that the applicant has, for example, recited in the disclosure that the labels might be of different format. However, this is not a disclosure of a size change in the labels, i.e., not .

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-5, 8-10, 12, 14, 21, 28, 73 and 76 are rejected (irrespective of 35 USC 112, first paragraph issues above) under 35 U.S.C. 103(a) as being unpatentable over Schafer (DE 2212995) in view of Stocq (US 6,306,475 B1) and Iwao (JP 05-294054). Schafer discloses a method of applying pieces of material to objects comprising: providing a material supply strip initially including a backing having first and second opposing surfaces and pieces of material removably arranged on both of the first and second surfaces and at least one applicator device, applying at least one piece of material from the first surface of the backing to at least one object with said at least one

Art Unit: 1734

applicator device, and applying at least one piece of material from the second surface of the backing to at least one object with said at least one applicator device (See Figs. 3-4, Page 18, lines 10-12, Page 20, 2nd paragraph). Furthermore, Schafer discloses that it is known to use two different labels, such as labels of different shape which would imply certain dimensions being smaller or larger (see translation of Schafer, page 4, lines 22-23, from applicant's IDS, paper #13, submitted 9-26-2002).

Schafer does not disclose that the backing and the pieces of material are being formed of substantially the same material, or centering the pieces of material on the first and second surface of the supply strip relative to each other.

Stocq discloses that it is known in the formation of labels to utilize the same material for the backing and the pieces of material (i.e., the labels - see column 3, lines 53-56). Furthermore, Stocq discloses that the materials can comprise polypropylene and polyethylene. One in the art would appreciate Schafer, which is silent as to the materials used is intended to be used with any conventional and known piece and backing system, including one wherein the materials are the same, as shown in Stocq. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized a backing and pieces of material made from the same material as is conventionally known and shown in Stocq.

Iwao discloses centering the pieces of material on the first and second surface of the supply strip relative to each other. One in the art would immediately appreciate that such a relationship can improve handling of the web, especially with regard to splicing of webs, since centered labels can avoid splicing cuts of the labels by merely cutting the

Art Unit: 1734

liner or supply strip. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized centered labels as in Iwao in order to improve handling of the web.

Regarding claim 2, the at least one applicator device includes at least one application station configured to apply pieces of material to objects, and wherein the applying of said at least one piece of material from the first surface and applying from the second surface includes passing the supply strip through the at least one application station.

Regarding claim 3, the at least one application station includes first and second application stations, and wherein the applying from the first surface includes passing the supply strip through the first application station, and the applying from the second surface includes passing the supply strip through the second application station.

Regarding claim 4, the supply strip is passed through the second application station after the supply strip is passed through the first application station.

Regarding claim 5, the at least one applicator device includes first and second sections, wherein the first surface being oriented to face the first section and the second surface being oriented to face the second section when the supply strip is passed through the first application station, the method further comprises re-orienting the supply strip so that the second surface faces the first section and the first surface faces the second section when the supply strip is being passed through the second application station (See Fig. 4).

Art Unit: 1734

Regarding claim 8, the method further comprises winding the supply strip into a roll on a spool after at least one of the applying from the first surface and applying from the second surface.

Regarding claim 9, the supply strip is initially in the form of a roll on a spool, wherein the method further comprises feeding the supply strip from the spool.

Regarding claim 10, the method further comprises winding the supply strip into a roll on a second spool after at least one of the applying from the first surface and applying from the second surface.

Regarding claim 12, the supply strip is initially in the form of a roll on a first spool, the method further comprises: feeding the roll of supply strip from the first spool to the first application station, and winding the supply strip into a roll on a second spool after the supply strip is passed through the second application station.

Regarding claim 14, wherein at least one piece of material from the first surface and at least one piece of material from the second surface are applied to a group of common objects.

Regarding claim 21, the pieces of material are labels.

Regarding claim 28, Stocq discloses using polyethylene.

Regarding claim 73, the first applicator device is used for applying at least one piece of material from the first surface and the second applicator device is used for applying at least one piece of material from the second surface.

Regarding claim 76, Schafer further discloses the additional limitation that the pieces of material on the first surface are positioned on the backing substantially

Art Unit: 1734

opposite to corresponding pieces of material on the second surface such that outer edges of the opposing pieces of material do not line up with each other (see Figures). Schafer also discloses different shapes, i.e., sizes, and Iwao discloses centering. See the rejection of claim 1 above

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schafer, Stocq and Iwao as applied to claim 5 above, and further in view of Moncrieff Baldwin et al. (USPN 5,143,466 and henceforth referred to as Baldwin). Schafer discloses re-orienting the supply strip between application stations. Schafer is silent to twisting. One in the art would appreciate twisting the supply strip to reposition the second surface. It is known and conventional to twist a strip approximately 180 degrees to reposition the second surface of said strip as shown, for example, by Baldwin (See Fig. 1, items 34, 61, 62, 51 and Col. 4, lines 27-32). It would have been obvious to one of ordinary skill in the art at the time of the invention to twist the supply strip of Schafer to reposition the second surface as shown by Baldwin in order to simplify the conveying system of Schafer to resemble that of a straight line, therefore eliminating the need for guide rollers that alter the direction of the conveyance path of the supply strip.

9. Claims 16, 20 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schafer, Stocq and Iwao as applied to claims 1 and 14 above, and further in view of Wochner (USPN 3,861,986). Schafer may be silent to the types of material on the supply strip. One in the art would appreciate pieces of material that are different may

Art Unit: 1734

be supplied. It is well known and conventional to provide a supply strip having different pieces of material as shown, for example, by Wochner (See Col. 1, lines 55-62). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide pieces of material on the first surface different from pieces of material on the second surface as applying different pieces of material to objects is well known and conventional as shown by Wochner.

Regarding claim 34, bottles as the objects are disclosed (See Wochner, Col. 1, lines 5-10).

10. Claims 22, 24-26, 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schafer, Stocq and Iwao as applied to claims 1 and 21 above, and further in view of Brandt et al. (USPN 6,379,761). Schafer may be silent to the particular properties of the supply strip, backing and labels. One in the art would appreciate such properties are well known and conventional for supply strips that provide labels to objects. It is well known and conventional to provide a supply strip with such properties as shown, for example, by Brandt et al. (See Col. 3, lines 2-4, 44-46, Col. 5, lines 10-16, Col. 6, lines 61-63, Col. 8, lines 36-37). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide such a supply strip, backing and labels with properties as those disclosed by Brandt et al. as they are well known and conventional properties of such and also to provide labels that can be easily and economically removed and re-applied (See Col. 2, lines 9-14).

Art Unit: 1734

Further regarding claim 33, the adhesive that removably adheres the pieces of material in Brandt et al. is considered to fall within the range of thickness as claimed. One in the art would appreciate the thickness of the adhesive of Brandt et al. as depicted is thinner than the backing (See Fig. 1, items 1 and 2).

11. Claims 23 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schafer, Stocq and Iwao as applied to claim 21 and above, and further in view of Amano et al. (USPN 5,376,417). Schafer may be silent to the particular material of the labels. One in the art would appreciate choosing any conventional label as is known in the art. Amano et al. disclose conventional labels made of PET (polyethylene terephthalate) (See Col. 1, lines 30-31). It would have been obvious to one of ordinary skill in the art at the time of the invention to choose PET as the material for the label as is well known and conventionally used for labels that are applied to objects.

Further regarding claim 35, PET is known to be transparent. One of ordinary skill in the art would appreciate conventional labels may be transparent and that PET labels may be transparent.

12. Claim 28 is alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Schafer, Stocq and Iwao as applied to claim 1 above, and further in view of Brandt et al. and Hirose. Schafer may be silent to the particular material used for the backing. Brandt et al. disclose conventional backings may be formed from many different polymer substrates, and cite examples such as polypropylene and polyester (See Col.

Art Unit: 1734

10, lines 4-8). Brandt et al. is silent to PET. One in the art would appreciate PET is included in the discussion by Brandt et al. and is a conventional polymer substrate used as a backing. Hirose et al. disclose polyesters and polypropylene may be used as backings, and provides a specific example to PET (See Col. 3, lines 55-65 and Col. 6, lines 40-42). One in the art would appreciate such materials are well known and conventional alternatives. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a PET backing as is a well known and conventional material used for supply strips as shown by Brandt et al. and supported by Hirose et al.

Response to Arguments

13. Applicant's arguments filed May 12th, 2004 have been fully considered but they are not persuasive.

14. With regard to applicant's arguments as to the 35 USC 112, first paragraph rejections, this rejection maintained. It is noted that applicant cites page 14 of the original specification as support for the claims, which recites that "the invention could be practice[d] with labels having many different configurations (e.g., different size, different shape, different labeling information)" (emphasis by applicant in page 3 of the remarks of the response filed 8-27-2003). Furthermore, it is noted that the specification that the labels might be a different format. However, the example the specification shows is that of the labeling information differing (for example, page 12, lines 11-16). The specification does not explicitly state that the labels on one backing material has

Art Unit: 1734

labels on a first surface of the backing material of one size, and labels on the second surface of the backing material of another size. The statement that the labels can be a different size as stated in page 14 can be interpreted many ways, and one of ordinary skill in the art, especially when faced with a disclosure that shows examples wherein the labels on both sizes of the backing material are the same, would interpret the statement to indicate that from processing run to processing run, the apparatus can use different configurations of labels, but inside a processing run, the labels are the same size.

15. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the knowledge to utilize the labels in a configuration as in Iwao (such that they are centered) would be generally available to one of ordinary skill in the art.

16. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was

Art Unit: 1734

within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Applicant argues that the limitation of the backing and the pieces of material being formed of the same material is hindsight reasoning. However, the level ordinary skill at the time of the invention, as represented by Stocq, explicitly discloses that among the materials known for the backing sheet include "those used for the face sheet" (column 3, lines 53-54). Such a selection would be available as a design choice for one of ordinary skill in the art. Therefore, one of ordinary skill would understand that the material selected can be the same.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George R. Koch III whose telephone number is (571) 272-1230 (TDD only). If the applicant cannot make a direct TDD-to-TDD call, the applicant can communicate by calling the Federal Relay Service at 1-866-377-8642 and giving the operator the above TDD number. The examiner can normally be reached on M-Th 10-7.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on (571) 272-1187. The fax phone

Art Unit: 1734

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



George R. Koch III
Patent Examiner
Art Unit 1734

GRK
9/18/2004